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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,569	04/12/2004	William Rolf Harvey	WH-1-gw	2633
7590	05/04/2005			
Michael I. Kroll 171 Stillwell Lane Syosset, NY 11791			EXAMINER STULTZ, JESSICA T	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/822,569

Applicant(s)

HARVEY, WILLIAM ROLF

Examiner

Jessica T. Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0404</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Objections*

Claims 1, 6-7, and 12 are objected to because of the following informalities: in claim 1, line 1, "apparatus for disposable" should be "apparatus comprising a"; in claims 6-7 and 12, "plurality...optical film" should be "plurality...optical films". Appropriate correction is required.

Claim 17 recites the limitation "the sunglasses" in lines 2 and 3; however, there is no mention of sunglasses previously in claim 17 or in dependent claims 12-13. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, the assumed meaning is "the eyeglasses". Claim 17 is also objected to because it does not end in a period, specifically, "is being positioned" should be "is being positioned."

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Glanzbergh.

Regarding claims 1 and 3, Glanzbergh discloses an apparatus comprising a disposable corrective optical film for attachment to the lens of eyeglasses (Column 5, lines 19-55, wherein the films "7" are disposable and removably attached to eyeglasses "3", Figures 1-3), comprising a corrective optical film having first and second sides (Shown in Figures 2-6), wherein the first

side is to be contiguous to the lens of the eyeglasses (Shown in Figures 1-6); and an adhering element, specifically an adhesive, disposed on the first side of the film to adhere the film to the lens of the eyeglasses (Column 6, line 52-Column 7, line 7, wherein the adhesive is "12", Figure 6).

Regarding claim 2, Glanzbergh further discloses that the adhering element is releasable (Column 5, lines 19-55, wherein the films "7" are removable from the eyeglasses "3", Figures 1-3).

Regarding claim 4, Glanzbergh further discloses that the adhering element comprises a peel-off adhesive backing (Column 5, lines 19-55, wherein the films "7" are peeled off of the sheet "8" and applied to the lens by an adhesive, Figures 1-8).

Regarding claim 5, Glanzbergh further discloses that the adhering element comprises spray-on mist (Column 6, line 52-Column 7, line 7, wherein the adhesive means can be applied using capillary action means, i.e. a spray-on mist, Figures 1-6).

Regarding claims 6-7, Glanzbergh further discloses a generally planar sheet having a plurality of corrective optical films disposed thereon, comprising at least two different optical characteristics (Column 5, lines 19-55, wherein the flat sheet "8" comprises a plurality of films "7" with different optical characteristics, Figure 2).

Regarding claim 8, Glanzbergh further discloses a peel and stick backing being disposed on the sheet to permit the film to be adhered to the lens of the eyeglasses (Column 5, lines 19-55, wherein the films "7" are peeled off of the sheet "8" and applied to the lens by an adhesive, Figures 1-8).

Regarding claim 9, Glanzbergh further discloses indicia indicating the optical characteristics of the corrective optical film disposed on the sheet (Column 5, lines 19-55, Shown in Figure 2).

Regarding claim 10, Glanzbergh further discloses an outline of the template of the corrective optical film being disposed on the sheet (Figures 2 and 7-8).

Regarding claim 12, Glanzbergh discloses a method of applying and removing disposable optical film to the lens of eyeglasses (Column 5, lines 19-55, wherein the films "7" are disposable and removably attached to eyeglasses "3", Figures 1-3), comprising: providing a generally planar sheet having a plurality of corrective optical films disposed thereon (Column 5, lines 19-55, wherein the flat sheet "8" comprises a plurality of films "7", Figure 2), the film having first and second sides (Shown in Figures 2-6), wherein the first side is to be contiguous to the lens of the eyeglasses (Shown in Figures 1-6); and placing an adhering element on the first side of the film to adhere the film to the lens of the eyeglasses (Column 6, line 52-Column 7, line 7, wherein the adhesive is "12", Figure 6).

Regarding claim 13, Glanzbergh further discloses the step of outlining a template of the corrective optical film on the sheet to allow a user to see the area of the corrective optical film (Figures 2 and 7-8), tracing the shape of the lens of the eyeglasses onto the area within the template on the sheet so that the corrective optical film can be properly sized (Figures 2 and 7-8); and cutting the corrective optical film from the sheet by cutting along the template and placing the film onto the lens of the eyeglasses (Column 5, line 19-Column 6, line 51, wherein the films "7" are cut from the sheet "8" and applied to the eyeglasses "3", Figures 1-8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glanzbergh.

Regarding claims 11 and 14, Glanzbergh discloses a disposable optical film and method of applying the optical film including the step of placing indicia on the corrective optical film indicating the optical characteristics of the film (Column 5, lines 19-55, Shown in Figure 2), but does not specifically disclose placing a warning on the corrective optical film to warn a user to cut the film properly. However, it is well known in the art of corrective ophthalmic lenses for the lenses to include a warning on the outside for the purpose of preventing the user from touching the lens and causing unwanted scratches and smudges on the lens. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the disposable optical film and method of applying the films to further comprise the step of placing a warning on the corrective optical film to warn a user to cut the film properly since it is well known in the art of corrective ophthalmic lenses for the lenses to include a warning on the outside for the purpose of preventing the user from touching the lens and causing unwanted scratches and smudges on the lens.

Regarding claim 15, Glanzbergh further discloses the step of placing a peel and stick backing on the corrective optical film to adhere the film to the lens of the eyeglasses (Column 5,

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lines 19-55, wherein the films "7" are peeled off of the sheet "8" and applied to the lens by an adhesive, Figures 1-8).

Regarding claim 16, Glanzbergh further discloses the step of removing the corrective optical film from the lens of the eyeglasses (Column 5, lines 19-55, wherein the films "7" are removable from the eyeglasses "3", Figures 1-3).

Regarding claim 17, Glanzbergh discloses a method of applying the optical film including, but does not specifically disclose applying a spray of water to the eyeglasses inhibiting the adhesive side from prematurely sticking to the eyeglasses while the film is being positioned. However, it is well known in the art of applying adhesive film to a surface to apply a spray of water to the surface to prevent the adhesive side from prematurely sticking to the surface for the purpose of providing extra time to allow proper alignment of the adhesive film on the surface. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of applying an optical films to further comprise the step of applying a spray of water to the eyeglasses inhibiting the adhesive side from prematurely sticking to the eyeglasses while the film is being positioned since it is well known in the art of applying adhesive film to a surface to apply a spray of water to the surface to prevent the adhesive side from prematurely sticking to the surface for the purpose of providing extra time to allow proper alignment of the adhesive film on the surface.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takeuchi, Burns et al, and La Haye et al are cited as having some similar structure to the claimed invention.

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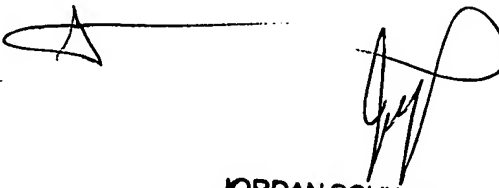

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339.

The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica Stultz  
Patent Examiner  
AU 2873  
April 29, 2005



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